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GROUP 3600

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/482,462

Filing Date: January 13, 2000

Appellant(s): ANDERSEN ET AL.

John A. Castellano, Esq.
For Appellant

SUPPLEMENTAL EXAMINER'S ANSWER

This is in response to the reply brief filed 16 August 2004.

Response to Argument

Appellant's argument on pp. 1-3 is based on piecemeal consideration of the references.

The pertinent rejection, under 25 USC 103(a), is based on the combination of two references, Witek et al. and NEXPO '97. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In particular, appellant argues (first para. on p. 3, lines 4-5), "... the examiner has not shown that NEXPO '97 at least teaches a sale (emphasis added) of several related ads based on entry of a single ad order". First, the claims contain no limitation as to the sale of ads. As appellant has correctly quoted on p. 2, the claims are limited to system and method supporting the entry, sale and management of ads. Said "supporting" is not given a clear definition in the spec., so the examiner is obligated to give the term its broadest reasonable interpretation.¹ The examiner interprets the term to mean facilitating the entry, sale and management of ads. NEXPO '97 teaches the re-use of content, and Witek et al. teaches ads as content. Re-use would facilitate or support sale of the ads by not requiring re-entry of related ads. The references jointly teach supporting the sale of ads.

Appellant also argues (p. 3, middle para.), "the QPS system is a page design and production system – not an advertising system." However, Witek et al. teaches an advertising system.

¹ Unless a term is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision" (MPEP § 2111.01.III). A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ...". An example does not constitute a "clear definition" beyond the scope of the example.

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Appellant also argues (p. 3, bottom) that "economy" is a poor reason for combining the two references because "just about anything could be combined for reasons of economy". Presumably those combinations that would result in diseconomies are not included in "just about anything". For just about anything which produces economies, appellant is correct, but that does not constitute a reason why such a combination would not have been obvious to one of ordinary skill in the art. To the contrary, appellant's argument demonstrates that there is a widespread desire to economize. That is a reason for, not against, combining the references.²

Appellant argues (p. 4, center) that the FCC's media ownership regulations (which, for example, limit common ownership of newspapers and television stations) would make the combination of references non-obvious. The reasoning is flawed because the claims are broad, limited to ads in "several media", not necessarily to ads in newspapers and TV. Witek et al. teaches ads in newspapers and on the Internet, which reads on "several media".³

Appellant argues (p. 5, 2nd para. from the bottom) that a declaration has been provided as evidence that the two references are not combinable. The entire declaration (as annotated by the examiner) has been appended to this supplementary examiner's answer. The declarant does state in para. 21 that the two references⁴ are "not combinable". The examiner believes that this simple conclusion should not be given weight for the following reason.

First, declarant continues (para. 22 and 23) by saying that if the references were combinable, they would have only narrow utility. See also para. 12, where the declarant notes (correctly) that Witek et al. teaches only simple, classified ads, and para. 18 and 19, where the declarant discusses limitations of NEXPO '97/QPS. What the declarant does not realize is that any prior art that reads on the instant claims, reads on the instant claims. It does not matter that the disclosed instant invention could be capable of much more.

² THE EXPECTATION OF SOME ADVANTAGE IS THE STRONGEST RATIONALE FOR COMBINING REFERENCES (MPEP § 2144).

³ In the Office action mailed on 23 May 2003 (Paper No. 15), it was made of record that "several" means "more than one".

⁴ For present purposes, "QPS" is synonymous with "NEXPO '97".

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Appellant notes (p. 5, 2nd para. from the bottom) that the examiner did not rebut an argument based on In re Dembiczak (appeal brief p. 14, bottom para.). In re Dembiczak deals with design claims, not utility claims (MPEP § 1504.06 and 2144.04.I). For utility inventions, the appropriate legal principle for combination of references is not that quoted by appellant from In re Dembiczak. Rather,

"There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." (MPEP § 2143.01.I, emphasis added).

As appellant's own argument suggests, the desire to economize is well known in the art, and indeed in most arts.

Appellant argues (p. 4, top and bottom para.) that the "very high investment costs" of combining the reference inventions would have to be taken into consideration when considering motivation to combine. There is no reasonable basis for estimating the cost of combining the references. The examiner would not hazard a guess, and neither has appellant's own expert in the appended declaration. The examiner maintains that clear economies would follow from combining the references, and that provides the reasonable expectation of success required for a *prima facie* case of obviousness (MPEP § 2142).

On p. 6, appellant misconstrues part of the examiner's answer by taking it out of context. The entire text is as follows.

"This is a case of technical fact more so than law. At central issue is what the QPS 2.0 software was and was not capable of at the time it was described in the NEXPO '97 and QUARK references. The examiner has interpreted the references to indicate that the NEXPO '97 passage reads on entry, sale and management of several related pieces of content based on entry of a single piece of content. If the examiner's has misunderstood this admittedly slim evidence, it should readily be possible to develop new information showing that the QPS 2.0 software of NEXPO '97 vintage was not capable of doing that, and especially that it could not readily be combined with the teachings of Witek et al.

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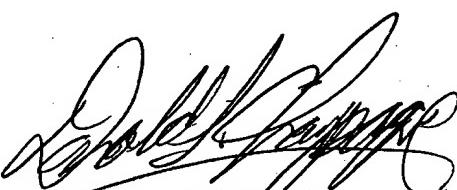
The appellant has not done that. The appellant has submitted opinions that the rejection is wrong, but nothing that qualifies as new technical evidence. The appellant has failed to meet his burden to provide evidence. The *prima facie* rejection should be affirmed." (Examiner's answer mailed 14 June 2004, last two para. on p. 8.)

In fact, appellant has provided the attached expert declaration as traversing evidence. However, the declarant has acknowledged (para. 22 and 23) that the reference inventions might be combined. This does not refute the *prima facie* case for obviousness.

At the bottom of p. 6, appellant is confused about "the Examiner's assertion in Point 21 on page 6". That is a reference to para. 21 of the Office action mailed on 23 May 2003, which begins on p. 3 of the examiner's answer. As stated there, all of the Office action, including its para. 21, is a response to "Applicant's arguments filed on 16 April 2003".

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Donald L. Champagne
Primary Examiner
Art Unit 3622

20 December 2006

DONALD L. CHAMPAGNE
PRIMARY EXAMINER

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Attorney Docket No. 45900-000391/US

APPENDIX TO
Supplemental Examiner's
Answer

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF:

Per Skjoldager ANDERSEN et al.

SERIAL NO.: 09/482,462

FILED: January 13, 2000

FOR: AN ADVERTISEMENT SALES AND MANAGEMENT SYSTEM

: CONF. NO. 7006

: EXAMINER: Donald Champagne

: GROUP: 3622

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DECLARATION UNDER 37 C.F.R. §1.132

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GROUP 3600

SIR:

I, Thomas Brandenborg, hereby declare

1. I am the Research Analyst of CCI Europe, where my mailing address is Axel Kiers
Vej 11, DK8270 Hojbjerg, Denmark.

2. My academic background is as follows:

Rudolf Steiner Waldorf-School of Aarhus, Denmark, graduated 1983.

Autodidact in Software Engineering, Danish standard curriculum, 1983-1987.

Autodidact in Typography and Prepress Production, Danish standard curriculum, 1987-
1990.

3. My industry experience is as follows:

1983-1987: Software engineer in Denmark's first PC retailer and solution center,
Danadata, and liaison to software providers such as Lotus Corp, IBM Corp and Xerox
Corp and adviser to these on software localization; further specialized in system level
programming and drivers development.

1987-1996: Founder and owner of consultancy and R&D house PC Doctors, later Brandenborg & Co, specializing in prepress and graphics arts, since expanded with a typesetting and imaging service bureau. We also developed and sold prepress productivity software, such as an automated image processing system, which came to be used at many US newspaper photo departments, yellow page, year book, catalog and prepress firms.

1996: After selling my company, I joined CCI Europe to head a Market Research team dedicated to advise management on future developments in news publishing and to provide recommendations on the long term direction of CCI solutions. As part of this, I have undertaken extensive research and studies at news publishing companies and, among other things, been a driving force behind the development of a next generation system for newsroom content management, collaboration and cross-media publishing.

European and US patents are currently pending on this system, and as inventor I have been deeply involved in the analysis of prior art, patent prosecution, claim interpretation and claim amendments.

During my employment at CCI Europe, my focus has been entirely on the editorial side of the business, not on the advertising side. Thus the documents pertaining to this declaration represent my first thorough study of CCI's advertising solutions.

Beyond technology itself, my main focus in my present function (as well as in my previous ones) is the research and in-depth understanding of fundamental tasks, processes, problems and challenges of a particular business or industry and how to provide ideal technology solutions to these.

4. In preparing this Declaration, I have read and considered at least the following documents pertaining to the above-identified patent application: (1) the specification, claims 1-24 and drawings as filed; (2) The Official Action dated April 25, 2002; (3) the

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Amendment filed August 22, 2002; (4) the Official Action dated October 22, 2002; (5) the Response filed April 16, 2003; (6) the Official Action dated May 23, 2003; and (7) the Response filed September 23, 2003. Furthermore, I have read the following publications and United States Patents: (1) U.S. Patent No. 6,253,188 to Witek et al.; (2) NEXPO '97, both of which have been asserted as prior art against the present application.

5. It is my understanding that independent claim 1 of the present invention recites a single system supporting entry, sales and management of several related advertisements (both classified and retail advertisements) in the same or multiple media, based on a single advertisement order. It is further my understanding that independent claim 1 recites entry, sales, and management in the conjunctive, namely separated by "and".
6. It is my understanding that entry, sales and management in the context of the present invention include such administrative tasks as selling, defining, creating, pricing, accounting, customer contract handling, creating statistics and sales automation, as set forth on page 4, lines 1-3 and 13-14 of the present specification.
7. It is my understanding that the present invention as defined in independent claims 1, 19, 25, and 44 facilitates simultaneous and parallel handling of multiple related classified and/or retail advertisements in order for these ads to be published in the same or in a plurality of publications or media.
8. It is my understanding that in the present invention, such related ads for the same or multiple publications and/or media can be identical (such as simple classified ads for newspaper and on-line publication) or completely different (such as for entire campaigns spanning newspaper, print, TV and other media).
9. It is my understanding that in the present invention, each advertisement can consist of advertisement material entered or composed directly by sales staff using the system

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or by material created in other systems (such as TV ads), but stored and/or managed in the present system for sales and administrative purposes.

10. It is further my understanding that the present invention supports the sales, management and administrative tasks of sales staff in the advertising departments of newspaper companies and other publishers, such as price calculation, accounting, customer contract handling, creating statistics and sales automation.

11. It is my opinion that Witek et al. teaches an Internet-based system for handling only classified ads directly between customers and consumers. Thus, Witek et al. is a purely customer-to-consumer based system.

12. It is my opinion that Witek et al. is limited to classified ads with relatively simple structure, composition and layout and not capable of handling more complex ad structures, such as for example a TV ad or a newspaper display ad.

13. It is my opinion that Witek et al. is limited to handling a single advertisement under each ad order, even if that advertisement may be copied to multiple media. Thus, it is, in my opinion, not able to manage multiple related ads under a single order, such as required for larger campaigns.

14. It is my opinion that Witek et al. teaches the option – in a customer-to-consumer based system – of placing identical copies of the same classified ad in newspaper print or in an on-line service. In my opinion, it is unclear whether Witek et al. supports simultaneous placement of these two copies of the same classified ad as a single process or whether two separate, sequential processes are required. Column 56, lines 20-21 imply that a single process may be possible, whereas column 56, lines 8-10 indicate that two processes are required.

15. Regardless of whether or not Witek et al. supports the placing of identical copies of a single classified ad in both newspaper print and on-line, it does not, in my opinion,

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teach multiple related ads for a single or multiple publications or media. Neither does Witek et al., in my opinion, teach the storing and managing of the various types of material, composition and layout required for more complex ads, such as retail ads in newspaper print or TV or even on-line banner ads.

16. In my opinion, Witek et al. is intended solely as a highly optimized system for entry of relatively simple classified ads by Internet end users and delivery of these ads to other Internet end users. Optionally, it can aggregate such classified ads from multiple newspaper companies (or other publishers) and normalize their classification and description. Witek et al. does not, in my opinion, teach any sales, management or administrative tasks required by ad departments of newspaper companies (or other publishers), such as price calculation, accounting, customer contract handling, creating statistics and sales automation.

17. It is my opinion that the product offered by Quark Publishing System (QPS) described on page 27 in NEXPO '97 is a layout and production tool for bringing text and graphics together in a creative layout.

18. NEXPO '97 has numerous references to "...accessing multiple publications..." and "...reuse of content of single text and picture files". I acknowledge that NEXPO '97 in general teaches the basic concept of reuse of content elements such as text and picture files. It is my opinion that these references should be seen in the context of purely layout processes in a production environment, which in my opinion is only a single minor element of the system according to the present invention, which addresses the entire sales, management and administrative tasks of an ad department.

19. Although no details or embodiments are described in NEXPO '97, I acknowledge that the principles of reuse it refers to might indeed also apply to advertisements when these are copied between media. However, such reuse would be limited to media with similar layout characteristics, such as classified text ads being copied between newspaper print and on-line publications. It is not technically feasible to automatically

transform and reuse newspaper print ads (or even elements thereof) into TV ads – or vice versa. Furthermore, regardless of any technical limitations on transformation of ads or ad elements between media, such reuse does not address the management of different ads that make up a larger campaign. It is my understanding that the system according to the present invention stores and manages multiple related ads under a single order, as well the material comprised by such ads, in order to address these requirements.

20. NEXPO '97 refers to numerous issues including publishing, customer and business matters. It specifically mentions QPS, Mactive, Managing Editor, Multi-Ad Creator, Pongrass, and PPI among others. Although no details or embodiments are described in NEXPO '97, I acknowledge that it teaches the existence of some individual systems to address some tasks in advertising departments, including some of the tasks addressed by the present invention. It is, however, my opinion that each of these systems constitutes unrelated and non-combinable sub-systems of the system according to the present invention. And even in case some of these systems were combinable, it is my opinion that the combined system would still be lacking the broad management of all advertising related tasks and information taught by the present invention.

21. Specifically, it is my opinion that the product offered by QPS is intended for use in a different environment, for different purposes and different media compared to Witek et al., thereby making QPS and Witek et al. not combinable. For example, Witek et al. only teaches classified ads that are automatically composed for on-line and optionally for print publication, whereas the design, layout and production features of QPS are mostly relevant for retail and display ads and in print media only.

22. It is my opinion that in case Witek, et al. and NEXPO '97 were combinable, this combination would still lack the ability to manage multiple related ads for one or multiple publications in one or multiple media under a single ad order, as well as several other features taught by the present invention.

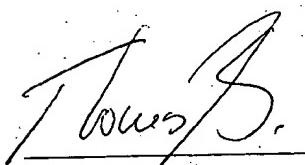
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(23) It is further my opinion that in case Witek, et al. and NEXPO '97 were combinable, this combination would still completely fail to teach the administrative tasks in ad sales departments' handling of ad orders including entry, sales and management tasks such as selling, defining, creating, pricing, accounting, customer contract handling, creating statistics, and sales automation, as set forth on page 4, lines 1-3 and 13-14 of the original specification.

24. It is my opinion that the present invention as defined in independent claims 1, 19, 25, and 44 facilitates simultaneous and parallel handling of multiple related classified and/or retail advertisements in order for these ads to be published in the same or in a plurality of publications or media. It is my opinion that this multiplicity and flexibility would not be provided by a combination of Witek et al. and NEXPO '97.

25. It is my opinion that independent claims 19, 25, and 44 are allowable for similar reasons to claim 1 above and dependent claims 2-18, 20-24, 26-43, and 45-50 are allowable by virtue of their dependency on allowable independent claims 1, 19, 25, and 44 for at least the reasons set forth above.

26. I confirm that all statements made herein to my own knowledge are true and that all statements made herein on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment or both under Section 1001 of Title 18 of the United States Code and that such any willful false statements may jeopardize the validity of the application or any registration resulting therefrom.



NAME

THOMAS BRANDENBURG

25 MARCH 2004

Dated